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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/780,088	02/17/2004	Binh T. Nguyen	0112300-1538	9894

7590 03/18/2008
Bell, Boyd & Lloyd LLC
P.O. Box 1135
Chicago, IL 60690-1135

EXAMINER

DEODHAR, OMKAR A

ART UNIT	PAPER NUMBER
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3714

MAIL DATE	DELIVERY MODE
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03/18/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/780,088	Applicant(s) NGUYEN ET AL.	
	Examiner Omkar A. Deodhar	Art Unit 3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4,6-42 and 44-81 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-42 and 44-81 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>2/29/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Non-Final Rejection

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6-11, 14-17, 19, 20, 22-42, 44-49, 52-56, 58-72 and 75-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Slot Machines: A Pictorial History of the First 100 Years”, Fifth Edition, by Marshall Fey in view of Barrie, (US 5,980,384).

Applicant's invention appears to be directed to a gaming device in which a primary game provides gaming elements for the secondary game regardless of any event in the primary game and regardless of any generated outcome of the primary game.

On Pages 74 and 75 of the Fey reference, Draw Poker Dice games such as the 1906 On-The-Level and On-The-Square are described. Referring to the brochure on Page 74 and the discussion on Page 75, Fey describes that "Player appeal and earnings were enhanced by the second chance feature on the original draw poker machines. Wins on the first toss were awarded bonus pays...In a no win situation the

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player had the option of saving any or none of the dice...He then flipped the dice not held a second time in hopes of improving the hand.”

A gaming element is interpreted as any element used in the game. For example, a gaming element such as a die (or a given symbol) is used in both primary and secondary games. The initial toss is a primary game. Regardless of any event and regardless of any generated outcome of the initial toss, the “second chance feature” permits the player to save any or none of the dice and receive another poker hand. This subsequent poker hand is the secondary game. A player may win an amount corresponding to the hand in the secondary game, as described in the brochure.

Fey therefore teaches the basic concept of the Applicant’s invention.

Examiner respectfully submits that the On-The-Square game described on Pages 75 and 75 is over a century old. As such, one would not expect the gaming machine to have electronics (processor, display, paytables stored in memory, data networks, etc.) as recited in the claimed limitations. However, it would have been obvious to one of ordinary skill in the art at the time of Applicant’s invention to incorporate such electronic elements, since it has been held that providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only routine skill in the art. *In re Venner*, 120 USPQ 192.

As disclosed by the Patents relied upon in this Office action, such electronic elements are common to modern gaming machines.

Claim 1:

Fey discloses the invention substantially as claimed, but is silent regarding a processor and electronic display device. Barrie discloses these elements in Figure 5. As explained above, this is a natural progression of the art.

Claim 2:

Poker is a game of risk.

Claim 3:

Fey teaches using the same set of dice in the primary and secondary games.

Claim 4:

The number of elements in the secondary game is based on amounts wagered in the primary game, at least in the sense that absent any initial wager, no game play takes place.

Claims 6, 7, 22, 23, 27, 44 and 45:

Fey discloses limitations as presented above. Fey is silent regarding using primary awards as wagers in a secondary game and placement of separate wagers in a secondary game. Barrie discloses integration of primary and secondary games, (Col. 3. Lines 5-20). This is interpreted as disclosing that awards may be used as wagers in second games, and that placement of a separate wager in a second game is permitted. It would have been obvious to one of ordinary skill in the art to permit such wagering in games of chance for the purpose of providing the player with a measure of decision making by which the player can optimize his/her chances of winning.

Claims 8-11, 46-49:

A winning hand in the second round is determined by player decisions after receiving the first set of dice. Poker is a game based on risk and hands are randomly determined.

Claims 14-17 and 52-55:

Fey (brochure on Page 74) shows primary and secondary game pay tables.

Claims 19, 24 and 28-30:

Fey discloses a poker game using dice. Fey does not teach a poker game using cards. Dice as used in a poker game, and cards as used in a poker game, are substitutable elements. The disclosure of providing card games is sufficient to extend to different card games such as blackjack. Additionally, note that poker games have winning outcomes formed from predetermined sets of game cards.

Claims 20 and 56:

Dice have cubical structure. Fey does not teach different sized cubes. Barrie teaches an electronic gaming machine. In an electronic game, different symbol sizes and types are provided. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to vary symbol sizes and symbol types in primary and secondary games to distinguish the secondary game from the primary game.

Claims 37 and 58:

Gaming elements for game rounds (primary and secondary) are randomly selected.

Claims 22, 25, 26, 31, 34, 38-42, 59, 60-72, 75-79:

Fey in view of Barrie, as presented above, discloses the claimed limitations. It is also noted that second players may place wagers in the device of Barrie, as in claim 68.

Claims 32, 33, 35, 36, 80 and 81:

Fey discloses the claimed limitations as presented above, however is silent regarding data networks and offering games via the internet. Barrie discloses providing games over networks, (Col. 14. Lines 19-22.) As explained above, this is a natural progression of the art.

Claims 12, 13, 18, 21, 50, 51, 57, 73 and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Slot Machines: A Pictorial History of the First 100 Years”, Fifth Edition, by Marshall Fey in view of Barrie, (US 5,980,384) as applied to the claims above, in yet further view of Gomez et al. (US 7,297,058).

Claims 12, 13, 21, 50, 51, 57, 73 and 74:

Fey in view of Barrie discloses the invention substantially as claimed. The references are silent regarding progressive gaming features. Gomez teaches wide-area progressive systems, (Gomez – Col. 10. Lines 52-63.) This is interpreted as disclosing the usage of progressive gaming across multiple rounds of game play. It would have been obvious to one of ordinary skill in the art to incorporate a wide area progressive

system into the gaming machine taught by Fey in view of Barrie for the purpose of allowing simultaneous play for a large jackpot.

Claim 18:

Fey in view of Barrie discloses the invention substantially as claimed. The references are silent regarding a secondary display. Gomez teaches a secondary display, (Col. 2. Lines 55-62.) It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to incorporate an additional display for the purpose of displaying video images to a player.

Response to Remarks

Applicant's arguments have been considered, but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Omkar A. Deodhar whose telephone number is 571-272-1647. The examiner can normally be reached on M-F: 8AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/OAD/

/Corbett Coburn/
Primary Examiner
AU 3714